

C. Remarks

At page 3, paragraph 5 of the Office Action, claims 1, 2, 3, 6-9, 11-21, 25-28, and 31-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinsner, Tutorials in 1999: Smart Cards. At page 4, paragraph 6 of the Office Action, claims 4, 5, 22, 23, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinsner as applied to claim 1 and further in view of Saitoh (U.S. Patent No. 5,929,414). And at page 4, paragraph 7 of the Office Action, claims 10, 29, and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinsner as applied to claim 1 and further in view of Jachimowicz (U.S. Patent No. 5,789,733). Applicant respectfully traverses each of these rejections.

Applicant has amended claim 1 to recite:

A smart card system, comprising: a smart card, comprising . . . a circuit . . . an antenna . . . a power converter . . . in communication with the antenna . . . and . . . a portable power supply in wireless electromagnetic communication with the power converter, wherein the portable power supply is external from a smart card reader.

Applicant submits that claim 1, as amended, is patentable and non-obvious over the Kinsner reference because it fails to disclose, teach or suggest each and every element recited in claim 1, as amended. For example, Kinsner fails to disclose, teach or even suggest, among other things: “[a] smart card system, comprising . . . **a portable power supply** in wireless electromagnetic communication with the power converter . . . **external from a smart card reader**,” as recited in amended claim 1. The combination of the Kinsner reference with the secondary references (e.g., Saitoh and Jachimowicz) also fails to disclose, teach or otherwise suggest this feature.

Although the Saitoh reference teaches a card having both contact and non-contact means, the cited reference does not teach or suggest, among other things, a “portable power supply . . . external from a smart card reader,” as recited in claim 1. Saitoh fails to teach or suggest “**a portable power supply** in wireless electromagnetic communication with the power converter, wherein the portable power supply is **external from a smart card reader**.” Applicant submits

that Saitoh teaches away from the smart card system recited in amended claim 1. For example, Saitoh discloses a contact/non-contact IC card 50 having a rectifier 99 provided with a power coil that takes the supply voltage from the IC card reader-writer 40 and produces the requisite driving voltage V for the IC card 50 (*see* Saitoh at col. 3, lines 52-58, for example). Such disclosure, however, teaches away for the smart card system recited in amended claim 1 wherein the smart card system includes “***a portable power supply*** in wireless electromagnetic communication with the power converter, wherein the portable power supply is ***external from a smart card reader.***”

Furthermore, because Saitoh teaches away from the invention recited in claim 1, as amended, Applicant submits that a person having ordinary skill in the art would not have any motivation to combine the Kinsner and the Saitoh references to arrive at the invention of claim 1. Applicant submits that a *prima facie* case of obviousness under 35 U.S.C. §103(a) requires, among other things, that the cited references, when combined, teach or suggest every element of the claim and, additionally, there must be some motivation to make the alleged combination. *See MPEP §2142.*

Accordingly, for at least the reasons discussed above, Applicant submits that claim 1, as amended, is patentable and non-obvious in view of Kinsner, Saitoh, and Jachimowicz, whether taken alone or in combination. Therefore, Applicant respectfully requests that the obviousness rejection of claim 1 be withdrawn. Applicant has amended claim 19 by rewriting it in dependent form and it now depends from claim 1, therefore, Applicant submits that claim 19 is patentable and non-obvious over the cited references. Therefore, Applicant submits that claims 2, 3, 6-19, 24, and 42-45, which depend from claim 1, either directly or indirectly, also are patentable and non-obvious over the cited references as discussed above.

Claim 39 has been amended to recite a method for transacting information between a smart card and a smart card reader, comprising:

generating a first electromagnetic signal having a first frequency;
[and] wirelessly radiating the first electromagnetic signal to a
smart card tuned to the first frequency from a portable power
supply ohmically detached from the smart card and the smart card
reader. . . .


Applicant submits that claim 39, as amended, is patentable and non-obvious over the Kinsner reference because it fails to disclose, teach or suggest, among other things generating and radiating a first electromagnetic signal "to a smart card . . . *from a portable power supply ohmically detached from the smart card and the smart card reader,*" as recited in amended claim 39. The combination of the Kinsner patent with any of the other cited secondary patents to Saitoh and/or Jachimowicz, whether taken alone or in combination, also fail to overcome the shortcomings of the Kinsner reference alone. Therefore, Applicant submits that claim 39, 40, 41, 51, and 52, which depend therefrom also are patentable and non-obvious over the cited references, taken alone or in combination.

Applicant is not otherwise conceding, however, the correctness of the Office's rejection with respect to any of the dependent claims discussed above and hereby reserves the right to make additional arguments as may be necessary because additional features of the dependent claims further distinguish the claims from the cited references, taken alone or in combination. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

D. Conclusion

As all of the issues raised by the examiner have been addressed, the applicant respectfully requests favorable reconsideration of this application and the issuance of a notice of allowance with respect to the pending claims. If the examiner believes that the present application is in condition for disposition other than allowance, applicant respectfully requests that the examiner contact the undersigned at the telephone number listed below so that the examiner's concerns may be expeditiously addressed.

Respectfully submitted,



Roberto Capriotti
Reg. No. 46,599

KIRKPATRICK & LOCKHART, LLP
Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, Pennsylvania 15222

Tel. (412) 355-8956
Fax (412) 355-6501
e-mail: rcapriotti@kl.com